

REMARKS

Claims 1-15 are pending. Claims 1 and 9 have been amended to Markush format. No new matter has been added by this amendment.

ELECTION AND REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT

In response to the action of April 7, 2004, applicants elect the invention of Group I (claims 1-6, 9-10, and 15), drawn to the embodiments of nucleic acid, vector, and transformant, and the human DEC2a sequence (SEQ ID NOs: 1 and 2). Pursuant to 37 C.F.R. § 1.143, applicants respectfully traverse the restriction requirement.

A. The Examiner states that election must be made to one specific sequence to which the claims will be restricted. As detailed above, applicants have amended claims 1 and 9 into Markush group format. MPEP § 803.02 states:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner *must* examine all members of the Markush group in the claim on the merits, *even though* they are directed to independent and distinct inventions. In such a case, the examiner ... will not require restriction (emphasis added).

The Markush group of each part of claim 1 consists of only three nucleotide or three amino acid sequences, all of which represent closely-related bHLH transcription factors. For example, human DEC2a (SEQ ID NO: 2) and human DEC2b (SEQ ID NO: 12) are identical except that DEC2b contains two additional amino acids that are not present in DEC2a. Thus, examination of these two sequences (and the nucleic acids encoding them) can be made without serious burden. Indeed, any prior art relevant to one will likely be relevant to the other. In addition, the mouse DEC2a sequence (SEQ ID NO: 14) is 73% homologous to the human DEC2a sequence and can be examined with the human sequence without serious burden.

B. The Examiner classifies Group I as being drawn to nucleic acid, vector, and transformant and Group II (claim 7) as being drawn to protein. The proteins of Group II are encoded by the nucleic acids of Group I. The Examiner states that the two groups are distinct, do

not render each other obvious, and are capable of supporting separate applications. However, as stated in MPEP § 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on its merits, *even though it includes claims to distinct or independent inventions*” (emphasis added). The search required for the sequences listed in claim 1 parts (b), (c), and (e) of Group I is exactly the same as the search required for the proteins of Group II (claim 7); thus, examination of claim 7 with the Group I claims in the present application does not cause serious burden.

III. The Examiner states that Groups I and III are related as product and process of use but that pursuant to MPEP § 806.05(h), the product and process of use are distinct and subject to the restriction requirement. Group III (claim 8) is drawn to a method of producing a protein and depends from claim 1 of Group I. It is standard practice in the U.S. Patent and Trademark Office to group claims drawn to a method of expressing a claimed nucleic acid with the claims to the nucleic acid. Also, as stated in MPEP § 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on its merits, *even though it includes claims to distinct or independent inventions*” (emphasis added). Inclusion of claim 8 with the Group I claims will not cause serious burden to the Examiner, since claim 8 depends from claim 1 and is limited to methods utilizing the nucleic acids of claim 1.

If the Examiner insists on maintaining the restriction between Groups I and III, note that as permitted under MPEP § 821.04, applicants will request rejoinder of Group III (claim 8) once the claims of Group I (claims 1-6, 9-10, and 15) are deemed allowable.

In view of the above, applicants request (1) reconsideration of the restriction requirement; (2) rejoinder of Groups I-III; and (3) examination of all of SEQ ID NOs: 1, 11, 13/ 2, 12, 14 together in the presently elected restriction group.

Applicant : Katsumi Fujimoto et al.
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Respectfully submitted,

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Janis K. Fraser, Ph.D., J.D.
Reg. No. 34,819

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906